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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,142	07/23/2001	Reto Sieber	F-7086	4481

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EXAMINER
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CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/911,142

Applicant(s)

SIEBER ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 October 2004 and 09 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/28/05, 10/12/04.
- ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 1/18/05.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **RESPONSE TO AMENDMENT**

1. Claims 1-11 and 13-34 are pending in the application, claim 12 has been cancelled.
2. Amendments to the claims, filed on October 8, 2004, have been entered in the above-identified application.
3. The restriction requirement mailed January 7, 2005 has been withdrawn due to Applicant's arguments in the response filed February 9, 2005.

### ***WITHDRAWN REJECTIONS***

4. The Double Patenting rejection to claims 1-30, made of record in the office action mailed April 6, 2004, page 2, paragraph #1 have been withdrawn due to Applicant's terminal disclaimer filed October 8, 2004.
5. The objections to claims 23 and 27, made of record in the office action mailed April 6, 2004, page 2, paragraphs #2 and #3 have been withdrawn due to Applicant's amendment in the response filed October 8, 2004.
6. The 35 U.S.C. §103 rejection of claims 1-16 and 19-32 as over Stough et al. (US Patent No. 5,711,124) in view of Hibler (US Patent No. 6,001,200) and Tuoriniemi (US Patent No. 6,444,307), made of record in the office action mailed April 6, 2005, pages 3-6, paragraph #5 has been withdrawn due to Applicant's amendment in the response filed October 8, 2004.
7. The 35 U.S.C. §103 rejection of claims 17, 18, 33 and 34 as over Stough in view of Hibler and Tuoriniemi and further in view of Avery (US Patent No. 2,373,092), Blok et al. (US Patent No. 6,177,163) and Samuelson (US Patent No. 5,736,001), made of record in the office

action mailed April 6, 2005, pages 6 and 7, paragraph #6 has been withdrawn due to Applicant's amendment in the response filed October 8, 2004.

### ***REJECTIONS***

8. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

#### ***Claim Rejections - 35 USC § 103***

9. Claims 1-11, 13-16, and 19-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson (U.S. Patent No. 6,607,621) in view of Stough et al. (U.S. Patent No. 5,711,124) and Kalwara et al. (U.S. Patent No. 6,426,129).

Regarding Applicant's claims 1 and 19, Swanson discloses a tape (*wall patch strip, col. 4, line 57*) comprising a backing layer (*body, col. 3, line 25*) consisting of a uniform material of planar construction (*substantially planar body, col. 3, lines 24-25 and figure 1b*), an adhesive layer (*col. 3, lines 39-40*) supported by the backing layer (*figure 1b*), and a peelable protective film (*removable backing, col. 3, lines 42-43*) in contact with the adhesive layer (*figure 1b*).

Swanson fails to disclose that the adhesive is a pressure sensitive adhesive and that a lateral longitudinal section of the tape includes perforations formed at least through the backing layer and the adhesive layer and a central region of the tape being free of the perforations.

Swanson also fails to disclose that the protective film includes at least one slit running in a longitudinal direction of the tape. The tape is capable of being folded upon itself in a transverse direction along a particular one of the at least one slit in such a manner that a folded

edge of the tape is defined thereby and at least a portion of the protective film which is adjacent to the folded edge is disposed as an outwardly facing layer on a side of the tape opposite to a side on which a remaining portion of the protective film is disposed as an outer surface.

Stough discloses drywall tape (*title*) comprising a liner sheet, a base sheet and a pressure sensitive adhesive in that order (*col. 5, lines 36-38*). The pressure sensitive adhesive coating with allows the tape to be adhered to the drywall panels without mud or activating liquid. The adhesive coating provides a means for adhering the tape to two sheets of drywall in response to the application of pressure (*col. 3, lines 32-36*).

The tape further that a lateral longitudinal section of the tape includes perforations formed through all the layers and a central region of the tape being free of the perforations (*figure 5*). The perforations allow air caught beneath the tape in application to escape, thereby avoiding bubbles beneath the tape, or regions in which the tape does not adhere to the drywall panel and make the tape more flexible to better extend into depressions (*col. 5, lines 4-18*).

Kalwara discloses an adhesive tape with a protective film, i.e. release liner, that has been scored, perforated or other cut in a longitudinal direction (*col. 1, lines 7-25*).

The protective film includes at least one slit (*perforations, col. 5, line 25*) running in a longitudinal direction of the tape (*figure 2*). The tape is capable of being folded upon itself in a transverse direction along a particular one of the at least one slit in such a manner that a folded edge of the tape is defined thereby and at least a portion of the protective film which is adjacent to the folded edge is disposed as an outwardly facing layer on a side of the tape opposite to a side on which a remaining portion of the protective film is disposed as an outer surface (*col. 5, lines 39-51*). Folding the tape upon itself in this manner allows the installed to remove one portion of

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the protective film at a time and helps to disengage the protective film from the adhesive surface (*col. 5, lines 39-51*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use pressure sensitive adhesive as taught by Stough as Swanson's adhesive in order to provides a means for adhering the tape to a wall in response to the application of pressure (*Stough col. 3, lines 32-36*). One of ordinary skill in the art would have been motivated to use pressure sensitive adhesive because pressure sensitive adhesive allows the tape to be adhered to the wall without mud or activating liquid (*Stough col. 3, lines 32-36*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add perforations to a lateral longitudinal section of the tape includes through all the layers and a central region of the tape being free of the perforations as taught by Stough to Swanson's tape in order to allow air caught beneath the tape in application to escape (*Stough col. 5, lines 4-18*). One of ordinary skill in the art would have been motivated to add perforations because the perforations allow air caught beneath the tape in application to escape, thereby avoiding bubbles beneath the tape, or regions in which the tape does not adhere to the drywall panel and make the tape more flexible to better extend into depressions (*Stough col. 5, lines 4-18*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add a perforated line to the protective film and fold the adhesive tape as taught by Kalwara to Swanson's tape in order to disengage the protective film from the adhesive surface. One of ordinary skill in the art would have been motivated to perforate the protective film and fold the adhesive tape because this allows the installed to remove one portion of the protective film at a

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time and helps to disengage the protective film from the adhesive surface (*Kalwara col. 5, lines 39-51*).

Regarding Applicant's claims 2 and 20, Kalwara discloses that the at least one slit includes two slits (*perforations, col. 5, line 25*) and the tape is folded along the particular one of the two slits in the transverse direction (*col. 5, lines 39-51*).

Regarding Applicant's claims 3 and 21, Swanson discloses that the backing comprises at least one of paper and a plastic film (*col. 3, lines 25-26*) and Stough discloses that the adhesive is a pressure-sensitive acrylate adhesive (*col. 3, lines 32-37*).

Regarding Applicant's claims 4 and 22, the backing of Swanson is deemed to be hand tearable transversely to the longitudinal direction of the tape since it is made of same material desired by applicant, i.e. paper (*col. 3, lines 25-26*).

Regarding Applicant's claim 5, Stough discloses that the adhesive layer has a non-adhering central strip, since the reference discloses that the central region of the tape is creased to facilitate application in corner regions (*col. 7, lines 33-35*), thereby forming a non-adhesive central portion. Furthermore, the combination of Swanson, Stough and Kalwara discloses that the particular one slit along which the tape is folded is disposed along a line between the non-adhering central strip and an adjoining region of the adhesive layer, since Kalwara discloses that the perforations are also centrally located (*figure 2*).

Regarding Applicant's claims 6 and 24, Swanson discloses that the tape is in the form of a roll (*col. 4, lines 57-59*). Therefore, the combination of Swanson, Stough and Kalwara disclose that the folded tape is in a form of a roll.

Regarding Applicant's claims 7 and 25, Swanson discloses that the tape further comprises an intermediate layer (*flexible texture coat layer, col. 3, line 54*) layer. The intermediate layer is deemed to be provided at least as a side of the roll at which the folded edge of the tape is disposed, since the texture coat layer cover the entire tape (*figures 1b and 3*). Thus when the tape is folded over a portion of the texture coat layer would still be one the side of the tape where the folded edge is.

Regarding claims 8 and 26, Swanson fails to disclose a dispenser for the tape.

Stough discloses that the tape may be dispensed from a roll or various roll tape dispensers may be employed for storing the and unrolling the tape (*col. 7, lines 3-5*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a tape dispenser as taught by Stough for Swanson's tape in order to provides a means for storing and dispensing the tap (*Stough col. 7, lines 3-5*).

Regarding Applicant's claims 9 and 27, Kalwara discloses that means are provided at least a side of the roll at which the folded edge of the tape is disposed for preventing adhesion to the dispenser, since the reference discloses that the protective film covers all of the adhesive (*figures 1 and 2*).

Regarding Applicant's claims 10 and 28, Swanson discloses that the tape is at least 3 to 4 cm wide when not folded, since the reference discloses that the strip can be made in various widths, such as 5 to 10 cm (*col. 5, lines 2-4*). The limitation at least 3 to 4 cm is taken to mean 3 cm or more.

Regarding Applicant's claim 11, the combination of Swanson, Stough and Kalwara discloses that at lease another lateral longitudinal section of the tape includes perforations



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formed at least through the backing and the adhesive layer, since Stough shows perforations on both lateral longitudinal sides of the tape (*figure 5*).

Regarding Applicant's claims 13 and 29, the combination of Swanson, Stough and Kalwara discloses that the perforations extend through the backing layer, the adhesive layer and the protective film, see above discussion regarding claim 1.

Regarding Applicant's claims 14 and 30, the backing of Swanson is deemed to comprise an open-pored material which exhibits adhesion properties for plaster, since it is made of same material desired by applicant, i.e. paper (*col. 3, lines 25-26*).

Regarding Applicant's claims 15 and 31, Stough discloses that the perforations have an average diameter of at least 3 millimeters, since the reference discloses that the perforations are approximately 1/8 of an inch, which is equivalent to 3.175 mm, in diameter (*col. 5, lines 20-21*).

Regarding Applicant's claims 16 and 32, Stough discloses that the perforations are at least one of essentially circular, polygonal and oval (*figure 5*).

Regarding Applicant's claim 23, the combination of Swanson, Stough and Kalwara discloses that at least a lateral longitudinal section of the tape includes perforations formed at least through the backing and the adhesive layer, see discussion regarding claim 1.

10. Claims 17, 18, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson, Stough and Kalwara as applied above, and further in view of Mead (U.S. Patent No. 4,417,677).

Swanson, Stough and Kalwara are relied upon as described above.

Swanson, Stough and Kalwara fail to disclose that the dispenser has at least one outlet slot for the tape and the dispenser comprises cardboard.

Mead discloses a portable dispenser for pressure sensitive adhesive tapes (*col. 1, lines 5-6*). The dispenser has at least one outlet slot for the tape (*figures 2 and 4*) and is made of cardboard (*col. 5, line 35*). The unique characteristics of the dispenser permit it to perform consistently and due to the increased strength of the geometric configuration the life of the dispenser greatly exceeds the life of the tape and can be used again or alternatively because the materials are inexpensive, the dispenser can be disposed of along with the empty spool (*col. 5, lines 33-50*). Furthermore, it is highly desirable to make dispensers from cardboard since it is inexpensive and can be discarded after the tape is consumed (*col. 1, lines 53-56*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Mead's tape dispenser as the tape dispenser of the combination of Swanson, Stough and Kalwara's tape in order to store and dispense the tape. One of ordinary skill in the art would have been motivated to use Mead's tape dispenser because its unique characteristics permit it to perform consistently and due to the increased strength of the geometric configuration the life of the dispenser greatly exceeds the life of the tape and can be used again or alternatively because the materials are inexpensive, the dispenser can be disposed of along with the empty spool (*Mead col. 5, lines 33-50*).

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

11. Applicant's arguments in the response filed October 8, 2004 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

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***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alicia Chevalier  
5/15/05